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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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William M. Lee, Jr.
LEE, MANN, SMITH, MCWILLIAMS, SWEENEY & OHLSON
P.O. Box 2786
Chicago, IL 60690-2786

EXAMINER

BENGZON, GREG C

ART UNIT PAPER NUMBER

2144

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,931

Applicant(s)

UNIACKE, MARK J.

Examiner

Greg Bengzon

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This application has been examined. Claims 1-21 are pending.

Priority

The effective date of the subject matter in the claims in this application is January 18,2002.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the user interface described in Claims 18-21 and the 'carrier carrying software' described in Claims 13-14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the

brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-21 of copending Application No. 10/032413. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 13-14 cite a 'carrier carrying software', said 'carrier carrying software' not having been sufficiently disclosed in the specifications.

Claims 18-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 18-21 cite a 'user interface for a network operator', said 'user interface' not having been sufficiently disclosed in the specifications.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 15-17 cite 'communication traffic signals', said signals not falling under any of the categories for statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taghadoss (US Patent 6052722) in view of Boer et al. (US Patent 5793765), hereinafter referred to as Boer .

With respect to Claim 1, Taghadoss discloses a method of managing a communication network comprising a plurality of ports, modelled according to a layer protocol, (Figures 1-2) , and a network management system, the communication network being partitioned into a plurality of subnetworks. (Column 1 Lines 35-65, Column 2 Lines 40-65)

With respect to Claim 4, Taghadoss discloses a method according to Claim 1, further comprising identifying incomplete trails within a said partition. (Column 1 Lines 60-65, Column 4 Lines 35-65, Column 6 Lines 40-65)

With respect to Claim 5, Taghadoss discloses a method of managing a communication network comprising a plurality of ports, (Figures 1-2) modelled according to a layer protocol, and a network management system, the communication network being partitioned into a plurality of subnetworks. (Column 1 Lines 35-65, Column 2 Lines 40-65)

With respect to Claim 8, Taghadoss discloses a method according to Claim 5, further comprising identifying incomplete trails within a said partition. (Column 1 Lines 60-65, Column 4 Lines 35-65, Column 6 Lines 40-65)

With respect to Claims 9, the Applicant describes a network with the same limitations as Claim 1. Claim 9 is rejected on the same basis as Claim 1.

With respect to Claim 10, the Applicant describes a network with the same limitations as Claim 5. Claim 10 is rejected on the same basis as Claim 5.

With respect to Claim 11, the Applicant describes a network management system with the same limitations as Claim 1. Claim 11 is rejected on the same basis as Claim 1.

With respect to Claim 12, the Applicant describes a network management system with the same limitations as Claim 5. Claim 12 is rejected on the same basis as Claim 5.

With respect to Claims 13 , the Applicant describes a carrier carrying software for the method of Claim 1. Claim 13 is rejected on the same basis as Claim 1.

With respect to Claims 14 , the Applicant describes a carrier carrying software for the method of Claim 5. Claim 14 is rejected on the same basis as Claim 5.

With respect to Claims 15, 16, and 17, the Applicant describes communication traffic signals for the methods of Claims 1,5, and the management system of Claim 12. Claims 15, 16, and 17 are rejected on the same basis as Claims 12, 1, and 5 respectively.

With respect to Claims 18-21, the Applicant describes a user interface with the same limitations as Claims 1, 5, 11, 12. Claims 18-21 are rejected on the same basis as Claims 1, 5, 11, 12.

However Taghadoss does not disclose certain features of the invention, as follows:

With respect to Claim 1, Taghadoss does not disclose the method comprising of generating, in respect of a said subnetwork, an off-network pointer exiting the subnetwork at one of said ports, whereby to establish a traffic carrying capability externally to the subnetwork.

With respect to Claim 2, Taghadoss does not disclose a method according to Claim 1, wherein the pointer is first generated in one of said layers and functionality at other layers is generated in response thereto.

With respect to Claim 3, Taghadoss does not disclose a method according to Claim 1, wherein the generation of said off-network pointer is performed by software.

With respect to Claim 5, Taghadoss does not disclose the method comprising determining those ports that represent valid termination points for trails, links and link connections in the subnetworks, whereby to generate trails interconnecting said connection termination points in different subnetworks.

With respect to Claim 6, Taghadoss does not disclose a method according to Claim 5, wherein the valid termination points for trails, links and link connections are first generated in one of said layers and functionality at other layers is generated in response thereto.

With respect to Claim 7, Taghadoss does not disclose a method according to Claim 5, wherein the generation of said valid termination points is performed by software.

Boer discloses a method for determining access points between subnetworks in a digital communications network. The network is partitioned into (abstractions of) subnetworks, with the status, in particular the transport capacity on a link to an adjacent network, of each subnetwork being indicated at so-called access points. (Figures 1-2) At these access points, properties of the network are

grouped, i.e. network elements and their properties are represented in a functionally combined way at a higher abstraction level. By means of the combined representation of network elements it is possible to determine a suitable link in a simple manner, without the need of using, in selecting the link, detailed information relating to the individual network elements. As a result, a substantial simplification in the control can be achieved. The repeated partitioning provides a substantially recursive procedure which expediently provides for a simplified determination of sublinks. Boer discloses of generating, in respect of a said subnetwork, an off-network pointer exiting the subnetwork at one of said ports, whereby to establish a traffic carrying capability externally to the subnetwork, said generation performed by software in the system. (Column 2 Lines 30-65) Boer discloses that the pointer is first generated in one of said layers and functionality at other layers is generated in response thereto. (Column 3 Lines 20-45, Column 5 Lines 25-65) Boer discloses determining those ports that represent valid termination points for trails, links and link connections in the subnetworks, whereby to generate trails interconnecting said connection termination points in different subnetworks. (Column 2 Lines 30-65, Column 8 Lines 30-65)

Taghadoss and Boer are analogous art because they present concepts and practices regarding management of digital communication networks. The Examiner respectfully suggests that at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the teachings of

Boer regarding access points between networks into the method and system of Taghadoss . The combination of Boer into Taghadoss would enable the system of Taghadoss to 1) generate, in respect of a said subnetwork, an off-network pointer exiting the subnetwork at one of said ports, whereby to establish a traffic carrying capability externally to the subnetwork, and 2) determine those ports that represent valid termination points for trails, links and link connections in the subnetworks, whereby to generate trails interconnecting said connection termination points in different subnetworks. The suggested motivation for doing so would be, as Boer suggests, to allow for a network having central control to be coupled to a network having a distribute control. Selecting links in networks having a central control requires a type of control information which is different from that for networks having distributed control. The combination of Boer and Taghadoss offers the possibility of said networks to cooperate efficiently. (Column 9 Lines 15-50) Furthermore, the combination allows the access points to interrogate the respective subnetworks for the available transport capacity. (Column 10 Lines 45-60)

Therefore it would have been obvious to combine Boer into Taghadoss in order to obtain the invention as described in Claims 1-21.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571)272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WILLIAM A. CUCHLINSKI, JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

gcb